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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,224	12/22/2003	Tomohisa Sakurai	17324	7638

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EXAMINER

JOHNSON III, HENRY M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/743,224	Applicant(s) SAKURAI, TOMOHISA	
	Examiner Henry M. Johnson, III	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5, 8-14, 17-22 and 24-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 4, 8-13, 17-22 and 24-32 is/are rejected.
- 7) ☒ Claim(s) 5 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Specification

The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3, 21-29 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,400,267 to Denen et al. Denen et al. teach the use of non-volatile memory to store utilization limits and parametric data for medical instruments (abstract). A control module (drive) is disclosed as connected to an electrically powered surgical scalpel; however, use with a vast array of electrically powered medial devices (probes) is disclosed (Col. 7, lines 35-41). The

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memory may be disposed in a connector (Fig. 2) thus implying a complementary mating connector. An actuator (switch) is disclosed (Fig. 3, # 37). The electrical contacts within the connectors are interpreted as the energy release and energy receiving units. Denen et al. teach the operational parameters are read from the memory, the request for the data and subsequent reading of the data comprising information exchange. Lack of a proper connection is inherent in that no data would be received. The control module may comprise a microprocessor to control the operating characteristics of a power supply module so that once equipment is connected to power supply and control apparatus, the control module may request a transfer of preprogrammed parametric data stored in the non-volatile memory. This data is then used by control module to regulate the power supplied by power supply module in accordance with the transferred parametric data. The parametric data may include, for example, voltage limits, current limits, instrument impedance, voltage setpoints, current setpoints, voltage ranges, current ranges and scale factors (Col. 9, lines 18-30). The step of reading the parametric data is interpreted as inherently including ceasing such reading when all the parameters are obtained. Denen et al. teach the updating (writing of data) into the memory of usage information for the specific medical device (Col. 2, lines 57-61).

Regarding claims 25 and 26, no further method step is provided.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,400,267 to Denen et al. as applied to claim 1 above, and further in view of U.S. Patent 4,038,625 to Tompkins et al. Denen et al. is discussed above, but does not disclose a latching connector. Tompkins et al. disclose an inductively coupled energy transfer connector using complementary transformer windings in portions of the connector (abstract). A treaded portion effectively "latches" the connector sections together. Specific applications include medical electronics (Col. 1, line 23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the latching connector as taught by Tompkins et al. in the surgical device of Denen et al. to provide a secure connection as such connectors are well known in the connector art to maintain two sections together.

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,400,267 to Denen et al. as applied to claim 1 above, and further in view of U.S. Patent 6,068,627 to Orszulak et al. Denen et al. are discussed above, but do not disclose specific surgical devices. Orszulak et al. disclose an energy delivery device for use with surgical instruments including those using laser, microwave and ultrasonic energy that includes means in a connector for identifying the specific surgical instrument attached. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use any of the medical instruments as taught by Orszulak et al. in the invention of Denen et al. as Denen et al. teach the use of such instruments without mentioning specific devices.

Claims 1, 12-14, 17-20 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,400,267 to Denen et al. in view of U.S. Patent Application Publication US 2002/0111621 to Wallace et al. and further in view of U.S. Patent 6,068,627 to Orszulak et al. Denen et al. and Orszulak et al. are discussed above, but do not disclose the use of a remote surgical arm. Remote surgical arms are well known in the art for endoscopic

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procedures as well as tele-surgical procedures. Wallace et al. teach a robotically controlled articulated arm for a surgical tool. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the robotic arm as taught by Wallace et al. in the invention of Denen et al. as the use of remote arms is pervasive in the art and therefore obvious to incorporate. It is further obvious to use the specific medical instruments taught by Orszulak et al. for the varied instruments disclosed by Denen et al.

Allowable Subject Matter

Claims 5 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

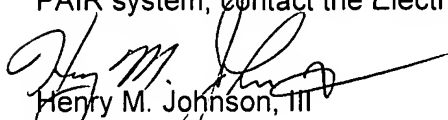
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Henry M. Johnson, III
Examiner
Art Unit 3739